

REMARKS/ARGUMENTS

Claims 39, 56-57, and 62 are canceled. Claims 32, 34, 38, 40-41, 58-61, and 63-64 are amended. Support for the amendment can be found, e.g., at page 3, lines 27-30 and page 15, line 18 – page 17, line 31. No new matter is introduced.

Claims 32, 34-38, 40-45, 55, 58-61, and 63-68 are pending in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

CLAIM OBJECTIONS

Claims 55-68 are objected to under 37 C.F.R. 1.75 as being substantial duplicates of claims 32, 34-36, and 38-45, respectively. See the Office Action, the paragraph bridging pages 2 and 3.

Applicants respectfully traverse. Claim 32, as amended, is directed to a method for inhibiting the expression of a target gene in a cell that expresses the targeted gene. The method comprises the steps of:

a) providing a composition comprising an mRNA-cDNA hybrid prior to contacting said cell, wherein the mRNA-cDNA hybrid is capable of inhibiting the expression of said targeted gene in said cell; and

b) contacting said cell with said composition under conditions such that the expression of said gene in said cell is inhibited.

Claim 55, on the other hand, requires a composition consisting of an mRNA-cDNA hybrid capable of inhibiting the expression of a targeted gene. Since claim 55 has a narrower scope compared to claim 32, it is not a substantial duplicate of claim 32.

Claim 56 is not a substantial duplicate of claim 32, either, because it requires a synthetic mRNA-cDNA hybrid. However, for the sole purpose of expediting the prosecution of the application, Applicants have canceled claim 56 and its dependent claim, claim 57, rendering the objections to claims 56 and 57 moot.

Claims 58-61 and 63-68, as amended, depend directly or indirectly from claim 55. Claims 34-36, 38, and 40-45 depend directly or indirectly from claim 32. Like claim 55 which is not a substantial duplicate of claim 32, claims 58-61 and 63-68 are not substantial duplicates of claims 34-36, 38, and 40-45, respectively, because the scopes of claims 58-61 and 63-68 are narrower than those of claims 34-36, 38, and 40-45.

Claim 62 has been canceled, rendering the objection to claim 62 moot.

In view of the foregoing, it is respectfully submitted that claims 55, 58-61, and 63-68 are not substantial duplicates of claims 32, 34-36, 38, and 40-45. The objection should be withdrawn.

CLAIM REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 39 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner rejected claim 39 because it recites “wherein said prokaryote is a virus.” See the Office Action, page 3, lines 7-12. Applicants have canceled claim 39, rendering the rejection moot.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 32 and 55 are rejected as being anticipated by *Hastie and Held, Proc. Natl. Acad. Sci. USA* 75: 1217-21, 1978 (“Hastie”). See the Office Action, page 3, line 19 – page 4, line 16.

Although Applicants believe that the previously presented claims 32 and 55 are not anticipated by Hastie, for the sole purpose of moving this application forward, Applicants have amended claim 32 as follows:

32. A method for inhibiting the expression of a target gene in a cell that expresses the targeted gene, comprising the steps of:

a) providing a composition comprising an mRNA-cDNA hybrid prior to contacting said cell, wherein the mRNA-cDNA hybrid is capable of inhibiting the expression of said targeted gene in said cell; and

b) contacting said cell with said composition under conditions such that the expression of said gene in said cell is inhibited.

In contrast, Hastie describes analysis of mRNA populations by cDNA-mRNA hybrid-mediated inhibition of cell-free protein synthesis. There is no indication whatsoever of contacting a cell with an mRNA-cDNA hybrid to inhibit the expression of a target gene in the cell. Since Hastie fails to teach every limitation of claim 32, it does not anticipate claim 32. Furthermore, Hastie requires a cell-free system for protein synthesis, while the method of claim 32 requires a cellular system for the expression of a target gene. Thus, Hastie teaches away from the method of claim 32 and does not render claim 32 obvious.

In view of the foregoing, it is respectfully submitted that claim 32, as well as claim 55 dependent from claim 32, is not anticipated or rendered obvious by Hastie, because Hastie not only fails to teach every limitation of claim 32 but also teaches away from the method of claim 32. The rejection should be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

Application Serial No. 09/920,342

Attorney Docket No. 89188.0022

Customer No.: 26021

Reply to Office Action dated June 28, 2005

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
HOGAN & HARTSON L.L.P.

Dated: September 27, 2005

By:

William E. Thomson, Jr.
Registration No. 20,719
Wei-Ning Yang
Registration No. 38,690
Attorneys for Applicants

500 South Grand Avenue, Suite 1900
Los Angeles, California 90071
Telephone: 213-337-6700
Fax: 213-337-6701